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EXAMINER

EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/785,094	Applicant(s) GUDORF, GREGORY D.	
	Examiner Hussein A El-chanti	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is responsive to amendment received on Sep. 27, 2004. Claims 1, 12, 13, 14, 17, 20, 26 and 42 were amended. Claim 16 was canceled. Claim 50 was newly added. Claims 1-15 and 17-50 are pending examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11-4, 6-10, 12-23, 26-39 and 41-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu, U.S. Patent No. 5,953,005.

Liu teaches the invention explicitly as claimed including a system and method for downloading songs over the internet in response to performing user authentication.

As to claim 1, Liu teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device (see col. 2 lines 40-52, user requests a song),

(b) associating the audio files with identification information (see col. 2 lines 40-52, the user is authenticated with the request),

(c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information (see col. 2 lines 40-52),

(d) receiving at said central location said identification information from a second device (see col. 2 lines 40-52),

(e) transmitting said audio files to said second device upon receipt of said identification information (see col. 2 lines 40-52, song is downloaded to the user's device).

As to claim 2, Liu teaches the method of claim 1 wherein said server is a web server and said files and information are received and transmitted via the Internet (see col. 2 lines 20-30).

As to claim 3, Liu teaches the method of claim 1 wherein at least one of said devices is a general purpose computer (see col. 3 lines 53-65).

As to claim 4, Liu teaches the method of claim 3 wherein at least one of said devices is a personal computer (see col. 3 lines 53-65).

As to claim 6, Liu teaches the method of claim 1 wherein at least one of said devices is a personal digital assistant (see col. 3 lines 53-65).

As to claim 7, Liu teaches the method of claim 6 wherein said personal digital assistant receives said audio files via wireless communication (see col. 3 lines 53-65).

As to claim 8, Liu teaches the method of claim 1 further comprising encoding said electronic files from a source of audio information (see col. 2).

As to claim 9, Liu teaches the method of claim 8 wherein said source is a compact disk (see col. 8 lines 20-35).

As to claim 10, Liu teaches the method claim 1 wherein said electronic files are compatible with the MPEG format when received at said central location (see col. 7 lines 5-15).

As to claim 12, Liu teaches the method of claim 1 further comprising receiving said identification from said first device (see col. 2).

As to claim 13, Liu teaches the method of claim 1 wherein said step of receiving at said central location said identification information comprises said second device automatically sending said identification information to said central location (see col. 2).

As to claim 14, Liu teaches the method of claim 12 or 13 wherein said identification information is associated with said device. (see col. 2)

As to claim 15, Liu teaches the method of claim 14 wherein said first device and said second device are the same device (see col. 2).

As to claim 16, Liu teaches the method of claim 1 wherein said identification information is associated with a user (see col. 2).

As to claim 17, Liu teaches the method of claim 16 wherein said step of associating said audio files with identification information comprises a user sending information which identifies the user (see col. 2).

As to claim 18, Liu teaches the method of claim 1 wherein said identification information is sent from said first device when said first device is connected to said central location via a network (see col. 3).

As to claim 19, Liu teaches the method of claim 18 wherein said network is the Internet (see col. 2).

As to claim 20, Liu teaches the method of claim 19 wherein said identification information is sent automatically by said first and second devices to said central location (see col. 2).

As to claim 21, Liu teaches the method of claim 1 further comprising the step of receiving at said central location a request for at least one of said files and wherein said step of transmitting comprises transmitting said at least one of said files (see col. 2).

As to claim 22, Liu teaches the method of claim 21 further comprising the step of comparing the identification information associated with said requested file with the identification information received during said step of receiving said identification information from said second device, and said step of transmitting is conditional upon the results of said comparison (see col. 2).

As to claim 23, Liu teaches the method of claim 22 further comprising the step of transmitting to said second device a list of the files associated with the identification information received from said second device (see col. 2).

As to claim 26, Liu teaches the method of claim 1 wherein said second device is at a geographic location remote from said first device (see col. 2-3).

As to claim 27, Liu teaches the method of claim 1 wherein said step of transmitting comprises downloading said file (see col. 2-3).

As to claim 28, Liu teaches the method of claim 27 wherein said step of transmitting comprises streaming said file to said second device (see col. 2-3).

As to claim 29, Liu teaches the method of claim 27 wherein said step of transmitting comprises permitting said second device to permanently store said file (see col. 2-3).

As to claim 30, Liu teaches the method of claim 1 further comprising:

(a) receiving at said central location electronic files representing audio signals from a third device, said third device having different identification information,

(b) storing the audio files from said third device on a portion of said storage media that is different from the portion uniquely associated with said identification information associated with said audio files from said first device (see col. 2-3).

As to claim 31, Liu teaches a system for storing and transmitting audio information comprising:

a processor;

memory;

data stored in said memory, said data identifying a plurality of users or devices, said data further comprising a plurality of files associated with audio information, each said file being uniquely associated with the identity of a single user or device;

a set of instructions executable by said processor, said instructions conditioning the transmission of a song from the system to a user or device based on the identity of the user or device associated with said audio information (see col. 2-3).

As to claim 32, Liu teaches the system of claim 31 wherein the total size of files stored in said data for a particular user or device is limited (see col. 2-3).

As to claim 33, Liu teaches the system of claim 32 wherein a file associated with a first user is identical to a file associated with a second user and said data comprises two copies of said file (see col. 2).

As to claim 34, Liu teaches the system of claim 31 wherein said system comprises a server (see col. 2).

As to claim 35, Liu teaches the system of claim 34 further comprising an audio player connected via a network to said server, said audio player being identified by at least some of the data identifying a plurality of users or devices (see col. 3).

As to claim 36, Liu teaches the system of claim 35 wherein said audio player comprises memory containing information identifying said player (see col. 2).

As to claim 37, Liu teaches the system of claim 36 wherein said audio player further comprises a speaker and a processor for playing said file (see col. 4).

As to claim 38, Liu teaches the system of claim 36 wherein said audio player sends the identification information automatically to said server (see col. 2).

As to claim 39, Liu teaches the system of claim 36 wherein said remote device is a PDA (see col. 3).

As to claim 41, Liu teaches the system of claim 31 wherein said identification information comprises a portable audio player (see col. 3).

As to claim 42, Liu teaches a method of storing and transmitting songs comprising:

uniquely associating a portion of the storage space on a server with a user or device;

associating said portion with a first identifier;

receiving said first identifier;

receiving a song file representative of a song; and

storing said song file in the portion of said storage space associated with said first identifier;

receiving a second identifier and a request for said song file;

comparing said second identifier with the identifier associated said requested song file;

transmitting said song file in response to said request depending upon the outcome of said step of comparing (see col. 2-3).

As to claim 43, Liu teaches the method of claim 42 wherein if a first file is received along with a first identifier and a second file is received along with a second identifier and said first file and second file are identical copies of one another, then said first file is stored on a portion of said storage space different from the portion where said second file is stored (see col. 2-3).

As to claim 44, Liu teaches the method of claim 43 further comprising the step of tracking the number of times a song file has been transmitted (see col. 2-3).

As to claim 45, Liu teaches the method of claim 42 wherein said step of storing said song file in the portion of said storage space associated with said first identifier occurs prior to said step of associating said portion with a first identifier (see col. 2-3).

As to claim 46, Liu teaches the method of claim 42 wherein said step of receiving said song file comprises receiving said song file from said user (see col. 2-3).

As to claim 47, Liu teaches the method of claim 42 wherein said step of receiving said song file comprises receiving said song file from a bank of song files (see col. 2-3).

As to claim 48, Liu teaches the method of claim 47 further comprising the step of said song bank preventing access to said song file stored at said song bank for an amount of time (see fig. 5).

As to claim 49, Liu teaches the method of claim 48 wherein said amount of time is determined by the number of times a user is permitted to download the song (see fig. 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu.

As to claim 5, Liu teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device, (b) associating the audio files with identification information, (c) storing

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said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information, (d) receiving at said central location said identification information from a second device, (e) transmitting said audio files to said second device upon receipt of said identification information (see the rejection of claim 1) where the second device can be a portable computer, laptop, PDA etc.. where the files are downloaded using wireless communication.

Liu does not explicitly teach the limitation "second device is installed in an automobile". Official Notice is taken that one of the ordinary skill in the art at the time of the invention would modify Liu to implement the second device in an automobile because doing so would allow the user to download and listen to songs from the internet and therefore overcome the need of using a physical storage device such as CD ROM or diskette and therefore having easier and more efficient method of saving audio files.

As to claim 11, Liu does not explicitly teach the limitation electronic files are compatible with the ATRAC3 format when received at said central location". Liu teaches the audio files can be saved in MPEG, .au, .snd, .aiff, etc. file formats. Official Notice is taken that it would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Liu by incorporating ATRAC3 format because doing so would allow the user to download audio files in different formats and using different software to play the audio file and therefore overcoming the limitation of a specific software to play the audio file.

Response to Arguments

4. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Cahill et al., U.S. Patent No. 6,574,377 (referred to hereafter as Cahill).

Liu teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device, (b) associating the audio files with identification information, (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information, (d) receiving at said central location said identification information from a second device, (e) transmitting said audio files to said second device upon receipt of said identification information (see the rejection of claim 1).

Liu does not explicitly teach the limitation "comparing the size of the electronic file with the amount of said portion" and "storing is conditional upon the result of such comparison". However Cahill teaches a method of storing data files where the computer checks if there is sufficient to store the file before transferring the file.

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Liu by incorporating the step of comparing the size of the file to the free space on the computer before downloading the file as taught by Cahill because doing so would prevent errors resulting from insufficient disk space and therefore

avoiding waste of time and resources when downloading files from a network (see col. 44 lines 30-col. 45 lines 5).

As to claim 25, Cahill teaches transmitting a notification to the user if the size of the electronic file plus the size of other files stored in said portion is greater than the amount of said portion (see col. 44 lines 30-col. 45 lines 5).

5. Claims 40 and 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Ferrel et al., U.S. Patent No. 6,199,082 (referred to hereafter as Ferrel).

Liu teaches a method of storing audio files comprises:

(a) receiving at a central location electronic files representing audio signals from a first device, (b) associating the audio files with identification information, (c) storing said audio files at said central location on at least a portion of a storage media, said portion uniquely associated with said identification information, (d) receiving at said central location said identification information from a second device, (e) transmitting said audio files to said second device upon receipt of said identification information (see the rejection of claim 1).

Liu does not explicitly teach the limitation "the identification information comprises a GUID". However Ferrel teaches a method of identifying data using GUID (see col. 24).

It would have been obvious for one of the ordinary skill in the art at the time of the invention to modify Liu by incorporating GUID to identify audio files as taught by Ferrel because doing so would identify an object with a unique string of characters that

are produced by concatenating the time, date and network card serial number of the computer at the time that the object is created and therefore makes it impossible to have two files with the same identifier.

6. Applicant's arguments filed have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that; A) Liu does not disclose music files are transferred to the server where they are stored in portions of the server's storage particularly associated with authentication information for the user can have access own audio files particularly associated with the user's authentication information not other users who have different authentication information associated with accessing different audio files.

In response to A) Applicant is arguing music files are transferred to the server where they are stored in portions of the server's storage particularly associated with authentication information for the user can have access own audio files particularly associated with the user's authentication information not other users who have different authentication information associated with accessing different audio files. These limitations are not found in the claims. Claimed subject matter not the specification is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1986); In re Self, 213 USPQ 1, 5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

7. This ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein A El-chanti whose telephone number is (571)272-3999. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hussein Elchanti

Feb. 5, 2005


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